

REMARKS

This Amendment is submitted in reply to the non-final Office Action mailed on February 5, 2008 and the Notice of Non-Compliant Amendment dated August 6, 2008. No fee is due in connection with this Amendment. The Director is authorized to charge any fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112703-306 on the account statement.

Claims 1, 4, 6-11, 14-16, 18-20 and 27-33 are pending in this application. Claims 2-3, 5-6, 12-13, 16-17 and 21-26 were previously canceled or withdrawn. In the Office Action, Claims 1, 4, 6-11, 14-16, 18-20 and 27-33 are rejected under 35 U.S.C. §112. Claims 1, 4, 6-11, 14-16, 18-20 and 27-33 are rejected under 35 U.S.C. §103. In response, Claims 1, 9, 11, 19, 27, 30 and 32-33 have been amended. The amendments do not add new matter. In view of the amendments and/or for the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

Applicants respectfully submit that this Response is being submitted, at least in part, in reply to the Patent Office's Notice of Non-Compliant Amendment dated August 6, 2008. In the Notice, the Patent Office asserts that the "amendments to the claims did not include markings to indicate all the changes that were made relative to the immediate prior version of the claims such as the deletion of terms indicated by a line through the deleted terms." See, Notice, page 2. In response, Applicants respectfully submit that the presently submitted Response includes all markings to indicate all of the changes that were made relative to the immediate prior version of the claims including the strikethroughs of the words "approximately" in Claims 1, 11, 27 and 32-33 and "15%" in Claims 9, 19 and 30. As such, Applicants respectfully submit that the present Response is now in compliance with proper procedure according to the USPTO.

In the Office Action, Claims 1, 4, 7, 8, 11, 14, 18, 19, 27-29, 32 and 33 are rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. Specifically, the Patent Office alleges that the claims recite the limitation "approximately," which does not appear to be originally disclosed by the instant specification and, therefore allegedly constitutes new matter. See, Office Action, page 2, lines 13-19. Further, Claims 1, 4, 7, 8, 11, 14, 18, 19, 27-29, 32 and 33 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. Specifically, the Patent Office alleges that "approximately" is synonymous with "about" and, therefore, the recitation of "approximately" is redundant and makes the term

“about” indefinite. In response, Applicants have amended Claims 1, 11, 27, 32 and 33 to delete the term “approximately.” As such, Applicants respectfully submit that these rejections are now rendered moot.

In the Office Action, Claims 9, 19 and 30 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. Specifically, the Patent Office alleges that the limitation “15%” lacks sufficient antecedent basis in the Claims. In response, Applicants have amended Claims 9, 19 and 30 to recite, in part, wherein the flavoring agent comprises 0.05 to 5% by weight of the oral product. The amendment does not add new matter. The amendment is supported in the specification at, for example, page 4, lines 12-23. Based on at least these reasons, Applicants respectfully submit that Claims 1, 4, 7, 8, 11, 14, 18, 19, 27-29, 32 and 33 fully comply with 35 U.S.C. § 112, first and second paragraphs.

Accordingly, Applicants respectfully request that the rejection of Claims 1, 4, 7, 8, 11, 14, 18, 19, 27-29, 32 and 33 under 35 U.S.C. § 112, first and second paragraphs be reconsidered and withdrawn.

In the Office Action, Claims 1, 4, 6-9, 11, 14-16, 18-19, 27-30 and 32-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/0119231 to Kumamoto et al. (“*Kumamoto*”) in view of Plant Patent No. 8,645 to Sturtz (“*Sturtz*”). For at least the reasons set forth below, Applicants respectfully submit that the rejections be withdrawn.

Currently amended independent Claims 1, 11, 27, 32 and 33 recite, in part, consumable products comprising Erospicata oil, an effective amount of menthol, a cooling agent and a heating agent, wherein the Erospicata oil comprises approximately about 0.01% to about 5% by weight of the total consumable product. The amendments do not add new matter. The amendments are supported in the specification at, for example, page 4, lines 1-2. In contrast, Applicants respectfully submit that there exists no reason why the skilled artisan would combine *Kumamoto* and *Sturtz* to arrive at the present claims and, even if combinable, *Kumamoto* and *Sturtz* fail to disclose each and every limitation of the presently claimed subject matter.

Applicants respectfully submit that the skilled artisan would have no reason to combine *Kumamoto* and *Sturtz* to arrive at the present claims. Specifically, Applicants respectfully submit that references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. *Sturtz* is directed primarily toward a new and distinct variety of a mint plant, now known as Erospicata. See, *Sturtz*, Abstract. Erospicata

can be used as a replacement to various cooling agents, including peppermint, to create a composition without epithelial irritation caused by large amounts of menthol. In fact, *Sturtz* explicitly discloses a low menthol mint plant for producing an oil wherein “menthol is substantially absent from the oil” of the plant. See, *Sturtz*, col. 2, lines 29-32. Therefore, *Sturtz* is entirely directed toward providing compositions that do not cause epithelial irritation by including large amounts of menthol. As such, *Sturtz* teaches away both from the combination with *Kumamoto* and from the present claims.

For example, *Kumamoto* is entirely directed toward warming compositions and teaches the use of menthol as a cooling agent. See, *Kumamoto*, page 2, [0026]. At no place in the disclosure does *Kumamoto* disparage the use of menthol because of any possible irritation that it may cause. As such, the incorporation of menthol disclosed in *Kumamoto* teaches away from a combination with the essentially menthol-free compositions of *Sturtz*, and the skilled artisan would have no reason to combine the cited references to arrive at the present claims. Similarly, the present claims require, in part, an effective amount of menthol in addition to another non-menthol cooling agent. Because *Sturtz* teaches a low-menthol mint plant for producing an oil wherein “menthol is substantially absent from the oil” of the plant, *Sturtz* also teaches away from the present claims.

Applicants respectfully disagree with the Patent Office’s assertion that “*Kumamoto* does not teach away” from *Sturtz* because “[t]he preferred cooling agents do not include menthol,” and because “Applicant implies that menthol is preferred and must be included in the composition which is not the case.” See, Office Action, page 5, lines 3-6. In contrast to this assertion, Applicants respectfully submit that it is not the claims of *Kumamoto* that are at issue here, nor whether *Kumamoto* discloses menthol in the “preferred cooling agents.” Instead, Applicants respectfully submit that it is the fact that *Kumamoto* even teaches that menthol can be used as a cooling agent that would lead the skilled artisan away from a combination with *Sturtz*. Instead, the skilled artisan would read page two, paragraph 26 of *Kumamoto*, which discloses “examples of the cooling agents which are preferably used in the invention include, but are not limited to, menthol,” and would be lead away from a combination with *Sturtz*, which teaches that menthol cause irritation upon ingestion and is substantially absent from the Erospicata oil.

Applicants respectfully submit that unless those portions of the art that teach away from the combination that is proposed are considered, Applicants respectfully submit that almost

every invention would be obvious. Hence, the reason the courts have time and time again cautioned against such a hindsight analysis. Therefore, Applicants respectfully submit that the Patent Office has improperly applied hindsight reasoning by attempting to selectively piece together teachings of each of the references in an attempt to recreate what the claimed invention discloses. The fact that the prior art *may* be modified in the manner suggested by the Patent Office does not make the modification obvious.

In sum, Applicants respectfully submit that the Examiner continues to pick and choose selected portions of the cited references to arrive at the present claims. However, when the references are properly considered as a whole, the references teach against or away from the combination and/or from the claimed invention. As a result, the skilled artisan would have no reason to modify or combine the cited references to arrive at the present claims.

Nevertheless, Applicants also respectfully submit that, even if combinable, *Kumamoto* and *Sturtz* do not disclose or suggest all of the elements of the presently amended independent Claims 1, 11, 27, 32 and 33. For example, *Kumamoto* and *Sturtz* fail to disclose or suggest a consumable product comprising Erospicata oil, an effective amount of menthol, a cooling agent and a heating agent, wherein the Erospicata oil comprises approximately about 0.01% to about 5% by weight of the total consumable product as required, in part, by independent Claims 1, 11, 27 and 32-33. In fact, neither *Kumamoto* nor *Sturtz* disclose any amounts of Erospicata oil at any place in the disclosures. Further, neither *Kumamoto* nor *Sturtz* disclose or suggest a consumable product having both an effective amount of menthol and a non-menthol cooling agent as is required, in part, by the present claims.

For example, and as discussed above, *Sturtz* is entirely directed toward a distinct variety of a mint plant, now known as Erospicata. See, *Sturtz*, Abstract. *Sturtz* explicitly discloses a low menthol mint plant for producing an oil wherein "menthol is substantially absent from the oil" of the plant. See, *Sturtz*, col. 2, lines 29-32. However, *Sturtz* fails to disclose or suggest any amounts of Erospicata oil used in consumable products. Further, *Sturtz* also fails to disclose or suggest a consumable product having both an effective amount of menthol and a non-menthol cooling agent, and even teaches away from any use of menthol.

Kumamoto is entirely directed toward warming compositions that comprise a cooling agent and a small amount of a compound represented by formula (I) and/or a warming agent. See, *Kumamoto*, page 1, [0007]. At no place in the disclosure does *Kumamoto* disclose or even

suggest any amounts of Erospicata oil used in consumable products. Further, and as discussed above, page two, paragraph 26 of *Kumamoto* discloses that “examples of the cooling agents which are preferably used in the invention include, but are not limited to, menthol.” Therefore, at best, *Kumamoto* discloses either a cooling agent that comprises menthol, or a non-menthol cooling agent. At no place in the disclosure does *Kumamoto* disclose or even suggest that the compositions disclosed therein may comprise both menthol and a non-menthol cooling agent as is required, in part, by the present claims.

For at least the reasons discussed above, the combination of *Kumamoto* in view of *Sturtz* is improper because the skilled artisan would have not reason to combine the cited references. Moreover, the cited references fail to disclose or suggest every element of the present claims and thus fails to render the claimed subject matter obvious.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claims 1, 4, 6-9, 11, 14-16, 18-19, 27-30 and 32-33 be reconsidered and the rejections be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same. In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Respectfully submitted,

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